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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/717,088 | 11/22/2000 | Thomas Sai Ying Ko | Q-61930 | 1770 |

7590 11/07/2003

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| EXAMINER |
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YU, GINA C

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| ART UNIT | PAPER NUMBER |
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1617

DATE MAILED: 11/07/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/717,088

Applicant(s)

KO, THOMAS SAI YING

Examiner

Gina C. Yu

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 09 October 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 22-38.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

11/5/03
Part of Paper No. 22

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Continuation from No. 5:

Applicants maintain the position that the background portion of the Gleichenhagen amounts to teaching away from employing the presently claimed polymers in a sprayable bandage composition. Examiner respectfully disagrees. Gleichenhagen cannot be characterized as teaching that all previously known film forming polymers that were well known and conventionally used in sprayable bandage composition art somehow have defects. Even if the conventional film forming polymers are taught to be inferior, examiner notes that it is well known in patent law that "a known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." See In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). In this case, examiner views that using a well known film forming composition for sprayable wound dressing for the same purposes does not render the composition novel or nonobvious. Applicants' arguments are found unpersuasive also because the reference specifically teaches using acrylic acids and methacrylic acid polymers, which are claimed in the instant application.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, applicants assert that examiner's proposed motivation to combine references is based on improper hindsight. Applicants' contention is based on the fact that each of the references fails to teach all the limitations of the claimed invention. Examiner reiterates that that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants' argument that Gleichenhagen teaches a composition that does not require a plasticizer is unpersuasive. There seems to be no particular teaching against adding the additive that is conventionally used in the art, as indicated in both Gleichenhagen and Tipton.

In response to applicant's argument that Gleichenhagen and Tipton are "incompatible" art, examiner notes that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Gleichenhagen and Tipton are both in the field of applicants' endeavor and directly pertinent to the problem with which the applicant was concerned, which is to formulate a sprayable wound dressing composition. Examiner views that Gleichenhagen and Tipton are analogous arts in this

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case and it would be proper to examine the patentability of the claimed invention by combining the references.

While applicants assert that the two references are not combinable because they teach different polymers and different film forming mechanisms, examiner notes that the examiner's proposed rejection does not require a motivation for a routineer to combine the different types of the film forming polymers or substitute one for the other. The general idea of using film-forming polymers in a sprayable wound dressing composition is well known, as disclosed in Gleichenhagen. The Tipton reference was cited to show, as indicated in the Office action dated August 23, 2003, paper no. 15, that adding tolnaftate in a sprayable film dressing composition is also well known in the art. Examiner views that the issue here would be why it would have been nonobvious, surprising, or unexpected to add tolnaftate in film forming compositions taught in Gleichenhagen.

Examiner respectfully disagrees with applicants' position that the combined teachings of Gleichenhagen, Tipton, and Modak fails to suggest a pump sprayable composition because Modak merely teaches a gel composition. Examiner reiterates that Modak was cited to show that the irritant-inactivating agents that are claimed in the instant claims are well known in pharmaceutical art. Examiner takes the position that the issue is not whether the combination of the three references would produce a pump-sprayable composition; rather, the issue here would be whether it would have been nonobvious, surprising, or unexpected to have added the well known pharmaceutical agents in the pump-sprayable wound dressing composition.